

REMARKS

Summary of Interview

On June 15, 2006, a telephone interview was conducted between Examiner and Applicant's representative, Jonathan D. Hanish. Applicant's representative asserted that Examiner did not properly address the Affidavits filed under 37 C.F.R. 1.132 in the Office Action dated May 9, 2006 and directed Examiner to review MPEP 716.04. Examiner instructed Applicant's representative to file a response to the Office Action, stating that any arguments made of record would be fully considered by Examiner and responded to appropriately.

Claim Rejections – 35 U.S.C. §103(a)

Claims 11, 34 and 57 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Shomo (U.S. Patent No. 4,660,832) in view of Johnson (U.S. Patent No. 2,425,245).

In response to the three affidavits filed on February 13, 2006 under 37 C.F.R. 1.132, Examiner asserts that the three affidavits are insufficient to overcome the rejection because each "include(s) statements that amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP §716." However, Examiner does not provide any explanation supporting this finding. Instead, Examiner merely cites from paragraph 7.66.02. According to MPEP §716.01(B), "Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as 'the declaration lacks technical validity' or 'the evidence is not commensurate with the scope of the claims' without an explanation supporting such

findings are insufficient.” Examiner is required to include a detailed explanation of the reasons why the affidavits are insufficient. Therefore, Applicant respectfully requests that Examiner provide a detailed explanation supporting her findings or otherwise withdraw the rejection.

Furthermore, Applicant respectfully submits that form paragraph 7.66.02 cited by Examiner is not appropriate in dismissing the relevancy of the three affidavits, which establish that Applicant’s claimed invention satisfies a long-felt but unsolved need. Whether or not a long-felt need affidavit includes statements that amount to an affirmation that the claimed subject matter functions as it was intended to function has no bearing on the relevancy of the long-felt need affidavit. According to MPEP §716.04(I), the relevance of long-felt need and the failure of others to the issue of obviousness depends on three factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. Second, the long-felt need must not have been satisfied by another before the invention by applicant. Third, the invention must in fact satisfy the long-felt need. Each submitted affidavit addresses all three of these factors. Examiner has not shown how any of the affidavits fails to satisfy all of these factors. In fact, Examiner has not addressed any of these factors at all. Examiner merely provides form paragraph 7.66.02, directed towards the invention working as intended. Given the MPEP’s explicit statement of relevancy factors for long-felt need affidavits, the form paragraph cited by Examiner is not appropriate in the present application. Form paragraph 7.66.02 is directed towards either an affidavit claiming unexpected results or affidavits that do not have specific factors regarding their relevance.

Additionally, Applicant respectfully submits that Shomo fails to disclose *hand railing*, a skin layer axially wrapped around *hand railing*, or a stretchable layer

releasably adhered to the outer surface of *hand railing*, as recited in Claim 11. As would be appreciated by one ordinarily skilled in the art, hand railing provides hand guidance and support along a structure. *Merriam Webster's Collegiate Dictionary, 10th Edition* provides the following definition:

hand-rail *n* : a narrow rail for grasping with the hand as support

Shomo is only directed towards a handle for use on products such as tennis rackets, racquetball rackets, golf clubs, baseball bats, and various other impact devices. Reference numeral 13a, cited by Examiner, is not a hand railing, but rather the handle of tennis racket 12. The handle of a tennis racket (or golf club, hammer, etc.) does not constitute hand railing. On Page 9 of the Final Office Action dated May 9, 2006, Examiner asserts that element 13a of Shomo is a hand railing and provides hand guidance and support along a device, such as a tennis racket. Applicant respectfully disagrees with Examiner's assertion. The handle of a tennis racket, or any of the other impact devices disclosed in Shomo, does provide hand support. The handle does not support the user's hand. Rather, the user's hand supports the handle. If the user lets go of the handle, it will fall to the ground. If the user exerts any amount of force on the handle, it will move, such as when the user swings the tennis racket. If the user holds the handle out to the side and leans on it, the user will fall to the ground. Therefore, handle 13a in Shomo clearly does not constitute hand railing as recited in Claim 11. Applicant respectfully requests that Examiner explain how the tennis racket handle of Shomo provides support and what it is supporting, or otherwise withdraw the rejection.

Applicant respectfully submits that since the cited prior art does not teach the hand railing limitations of Claim 11, Examiner has failed to establish that all elements of the invention are disclosed in the prior art.

Furthermore, the cited prior art fails to disclose a skin layer axially *wrapped* around the outer surface of a hand railing such that the edges of the skin layer do not overlap, as recited in Claim 11. On Page 9 of the Final Office Action dated May 9, 2006, Examiner argues that the skin layer in Johnson is wrapped about the handle. However, Applicant respectfully submits that Johnson does not teach a skin layer axially *wrapped* around the outer surface of hand railing, as recited in Claim 11. *Merriam Webster's Collegiate Dictionary, 10th Edition* provides the following definition:

wrap vb wrapped 1 a : to cover esp. by winding or folding

However, as seen in FIGS. 3, 4 and 6, the skin layer in Johnson is fixed in a U-shape before it is applied to the handle of the air hammer. Johnson describes this “outer U-shaped member 8 ... which may be made from any suitable material having sufficient resiliency or springiness to cause the grip to engage the drill handle 4 with sufficient pressure to frictionally retain it in operative position thereon. Certain types of hard rubber or plastics have been found suitable.” (Col. 3, lines 19-47). The skin layer in Johnson is constantly in a U-shape. It is not *wrapped* around the handle, but rather clipped onto the handle. This inherent tension and firmness of the skin layer actually teaches away from it being wrapped or folded around the handle, since the flexibility required for wrapping is not consistent with the firm structure taught by Johnson.

Applicant respectfully submits that since the cited prior art fails to teach a skin layer axially *wrapped* around the outer surface of hand railing, Examiner has failed to establish that all elements of the invention are disclosed in the prior art.

Applicant respectfully submits that the cited prior art fails to disclose all elements of Claim 11 and that the invention of Claim 11 would not have been obvious to one ordinarily skilled in the art at the time the invention was made. Therefore, Applicant

respectfully submits that the invention of Claim 11 is patentable over Shomo in view of Johnson.

The same arguments made above with respect to the patentability of Claim 11 are applicable to the patentability of Claims 34 and 57 as well

Therefore, Applicant respectfully submits that Claims 11, 34 and 57 are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 23, 46 and 69 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Shomo in view of Johnson and Kobe et al. (U.S. Patent No. 6,610,382 B1).

The same arguments made above with respect to the patentability of Claim 11 are applicable to the patentability of Claims 23, 46 and 69 as well. Therefore, Applicant respectfully submits that Claims 23, 46 and 69 are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 74, 76 and 78 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Shomo in view of Johnson, and further in view of Oseroff et al. (U.S. Patent No. 3,848,480).

Since Claims 74, 76 and 78 depend from independent Claims 11, 34 and 57 respectively, they are also patentable as they contain the same limitations as their respective parent claims. Therefore, Applicant respectfully submits that Claims 74, 76 and 78 are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 75, 77 and 79 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Shomo in view of Johnson and Kobe, and further in view of Oseroff.

Since Claims 75, 77 and 79 depend from independent Claims 23, 46 and 69 respectively, they are also patentable as they contain the same limitations as their respective parent claims. Therefore, Applicant respectfully submits that Claims 75, 77 and 79 are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned at 775-586-9500.

Respectfully submitted,
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